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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Proceeding	86325151
Applicant	Midlands Technical College
Applied for Mark	YOU CAN GET ANYWHERE FROM HERE
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**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
TRADEMARK TRIAL AND APPEAL BOARD**

Application: U.S. Application Serial No. 86325151, filed July 1, 2014

Mark: **YOU CAN GET ANYWHERE FROM HERE**

Goods: International Class 041: Educational services, namely, providing courses of instruction at the college level and distribution of course material in connection therewith; Educational services, namely, providing on-line courses of instruction at the college level; Educational services, namely, conducting distance learning instruction at the college level; Educational services, namely, conducting classes in the field of career development and distribution of training material in connection therewith; Educational services, namely conducting classes in the field of personal development and distribution of course and educational materials in connection therewith.

Examiner: Donald Johnson, Law Office 104

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III. DESCRIPTION OF THE RECORD

The record contains the following relevant entries: 1) the Application entered July 1, 2014, 2014; 2) the Initial Office Action from Examining Attorney Donald Johnson (the “Examining Attorney”) issued October 17, 2014; 3) Applicant’s Response entered February 12, 2015; 4) the Examining Attorney’s Final Office Action issued March 6, 2015; 5) Applicant’s Request for Reconsideration entered September 8, 2015; and 6) the Examining Attorney’s Reconsideration Letter issued October 14, 2015.

IV. STATEMENT OF THE ISSUES

Applicant is appealing the §2(d) likelihood of confusion rejection of Applicant’s mark YOU CAN GET ANYWHERE FROM HERE made in the Final Office Action. In response to the rejection, Applicant filed a Request for Reconsideration and Notice of Appeal on September 8, 2015. The likelihood of confusion rejection was reiterated in the Examining Attorney’s denial of Applicant’s Request for Reconsideration. The Trademark Trial and Appeal Board (“Board”) resumed the appeal on October 14, 2015, and provided Applicant 60 days therefrom to file its appeal brief.

Applicant respectfully requests that the Board reverse the likelihood of confusion rejection, and allow the mark to pass to publication.

V. RECITATION OF FACTS

The application is for the mark YOU CAN GET ANYWHERE FROM HERE (“Applicant’s Mark”) in standard format, for use in connection with “Educational services, namely, providing courses of instruction at the college level and distribution of course material in connection

therewith; Educational services, namely, providing on-line courses of instruction at the college level; Educational services, namely, conducting distance learning instruction at the college level; Educational services, namely, conducting classes in the field of career development and distribution of training material in connection therewith; Educational services, namely conducting classes in the field of personal development and distribution of course and educational materials in connection therewith,” in International Class 041. The application was filed on the basis of use in interstate commerce (Section 1A of the Trademark Act, 15 U.S.C. §1051(b)) on July 1, 2014).

The Registration cited is for the mark YOU CAN GET THERE FROM HERE (the “Registered Mark”) in standard format, for use in connection with “educational services, namely, offering courses of instruction in art, music, audio, film, video, television and digital media,” in International Class 041.

VI. ARGUMENT

Applicant respectfully asserts that the Examining Attorney has not satisfied the burden of proving a *prima facie* case of likelihood of confusion between Applicant’s Mark and the Registered Mark. The Patent and Trademark Office (the “Office”) bears the “burden of proving that a trademark falls within a prohibition of Section 1052.” *In re Mavety Media Group Ltd.*, 33 F.3d 1367, 1371 (Fed. Cir. 1994). In determining whether two marks are confusingly similar, the Office applies the *Dupont* factors. *In re E. I. DuPont de Nemours & Co.*, 476 F.2d 1357 (CCPA 1973). Among these, the marks themselves must be compared and considered in connection with the particular goods or services for which they are used. *In re National Data Corp.*, 753 F.2d 1056, 1058, 224 USPQ 749, 750-51 (Fed. Cir. 1985). Also, the goods and/or services identified in the application and registration must be compared to determine if they are related or if the activities surrounding their marketing are

such that confusion as to origin is likely. *Guardian Prods. Co. v. Scott Paper Co.*, 200 U.S.P.Q. 738 (TTAB 1978). The care likely to be exercised by purchasers, as well as the strength of the cited mark, or any other factor relevant to the likelihood of confusion inquiry, must also be considered. *DuPont*, 476 F.2d at 1360-61.²

Applicant submits that the Examining Attorney's evidence did not sufficiently prove a likelihood of confusion. Additionally, Examining Attorney gave no weight to Applicant's evidence, which weighs decidedly against a likelihood of confusion. Most notably, Examining Attorney did not adequately consider the consumer standpoint, which should be paramount. For these and the following reasons, Applicant requests that the Examining Attorney's rejection be reversed.

1. The Marks Are Not Similar.

The first *DuPont* factor weighs against a finding of likelihood of confusion.

As the Federal Circuit recently explained, "[m]arks are compared along the axes of their 'appearance, sound, connotation and commercial impression.'" *Juice Generation, Inc. v. GS Enterprises, LLC*, 794 F.3d 1334, 1340 (July 20, 2015) (quoting *DuPont*, 476 F.2d at 1361). Although confirming that marks are to be compared in their entirety, the Federal Circuit clarified that "[t]hat does not preclude consideration of components of a mark." *Id.* Rather, the comparison of the marks

² Specifically, the thirteen *DuPont* factors are: (1) The similarity or dissimilarity of the marks in their entireties as to appearance, sound, connotation and commercial impression; (2) the similarity or dissimilarity and nature of the goods or services as described in an application or registration or in connection with which a prior mark is in use; (3) the similarity or dissimilarity of established, likely-to-continue trade channels; (4) the conditions under which and buyers to whom sales are made, i.e., "impulse" vs. careful, sophisticated purchasing; (5) the fame of the prior mark (sales, advertising, length of use); (6) the number and nature of similar marks in use on similar goods; (7) the nature and extent of any actual confusion; (8) the length of time during and conditions under which there has been concurrent use without evidence of actual confusion; (9) the variety of goods on which a mark is or is not used (house mark, "family" mark, product mark); (10) the market interface between applicant and the owner of a prior mark; (11) the extent to which applicant has a right to exclude others from use of its mark on its goods; (12) the extent of potential confusion, i.e., whether de minimis or substantial; and (13) any other established fact probative of the effect of use. Herein, Applicant refers to certain *DuPont* factors by these designated numbers.

“requires heeding the common-sense fact that the message of a whole phrase may well not be adequately captured by a dissection and recombination.” *Id.* at 1340-1341.

The marks at issue are distinct. Particularly, Applicant’s Mark substitutes the term “ANYWHERE” for the word “THERE” in the Registered Mark. This substitution significantly impacts the difference in the overall message conveyed by each mark.

Examining Attorney discounted this difference by relying on the alleged similar dictionary definitions of these terms. *See* Final Office Action (at attachments 1-4). However, Examining Attorney concedes that “the meaning of these words differ to a degree.” *Id.* Indeed, these terms have opposite meanings: “ANYWHERE” meaning “*any* place” and “THERE” meaning “*that* place.” Rather than support Examining Attorney’s position, therefore, the dictionary definitions support Applicant’s position that that these terms greatly change the central message conveyed by the marks.

As argued by Applicant in its February 12, 2015 Response to the Initial Office Action:

ANYWHERE does not equate to THERE; it is opposite of THERE. THERE is a single destination; it points to one (unspecified) place. ANYWHERE points to an infinite number of destinations. The difference is not just one of magnitude; it is a different idea. The message of Registrant’s mark is that of a possibility; the message in Applicant’s mark is of unlimited opportunity.

Importantly, the different messages conveyed by the marks are consistent with Applicant’s and Registrant’s different underlying missions. Being a technical and vocational school, Applicant strives to prepare its students for more immediate gainful employment “anywhere.” Registrant is instead a school specialized in entertainment, media and the arts, and thus strives to prepare its students for a more targeted job placement.

Based on the foregoing, Applicant respectfully asserts that Examining Attorney failed to support a conclusion that Applicant’s and Registrant’s marks are similar.

2. The Services Are Not Related.

The second *Dupont* factor also weighs against a finding of likelihood of confusion.

a. Examining Attorney's evidence is insufficient to prove relatedness.

The Board recognizes that “it is the Examining Attorney’s burden to make a *prima facie* showing that the [services] are related.” *In re Princeton Tectonics, Inc.*, Serial No. 77436425, 95 U.S.P.Q.2d 1509, 1512 (TTAB 2010) (precedential). Here, the primary factual evidence offered by the Examining Attorney are third-party registrations and excerpts from Internet websites attached to the Initial Office Action and the Reconsideration Letter. Applicant respectfully asserts that these materials are insufficient to prove relatedness of the respective services.

i) Initial Office Action Evidence

In the Initial Office action, Examining Attorney attached copies of third party registrations for educational services and pages from certain of these third party registrants’ websites to support his assertion that Applicant’s and Registrant’s educational services, and presumably *any* educational services, are related. *See* Initial Office Action (attachments 2-38). Applicant respectfully asserts that the cited third party registrations and related website materials are insufficient to prove relatedness of the respective services.

As the Board has held, it is improper to use *per se* rules of relatedness. *See, e.g., The Nestle Company Inc. v. Nash-Finch Co.*, 4 U.S.P.Q.2d 1085, 1090 (TTAB 1987) (precedential). Applying this policy, legal wording used to describe services in the specialized context of a Federal trademark application should not be given significant weight as “proving” a presumption that services are related. *See, CNL Tampa Int’l v. Gomulka Palazzolo*, Opp. No. 91163724, p. 12 (TTAB 2007) (non-precedential) (“Taken to its absurd extreme, if third-party registrations alone are considered sufficient to prove that goods and services are related, then virtually all consumer products and

services would be related. Accordingly, a *per se* rule regarding the relatedness of goods and services is contrary to trademark law which requires that each case be decided on the basis of all the relevant facts in evidence.”).

In *CNL*, the Board explicitly rejected the argument that third-party registrations, standing alone, were enough to prove relatedness of the goods or services. *Id.* at p. 9. Particularly, the over 100 third-party registrations listing opposer’s goods and applicant’s goods were found not sufficient to infer the relatedness of the goods. *Id.* (“We will not draw an inference from the third-party registrations that restaurant services and clothing are legally related products such that the use of PELAGIA in connection with shirts so resembles PELAGIA for restaurant services as to likely cause confusion.”).

By contrast to the *CNL* case, many less than 100 third-party registrations were identified here. In addition to the comparatively small number of third-party registrations presented, the content of these registrations further diminishes their probative value. First, a majority of the registrations cited are for *primary* university marks or logos (e.g., University of Houston mascot), rather than secondary slogans. At least the following registrations cited are for marks recognized as a and oftentimes *the* primary designation of the respective owners: UNIVERSITY OF MOUNT UNION (US 4046407), FLORIDA SOUTHERN COLLEGE (US 4111122), MCAD (US 4087264), Q (US 4423778), CHATTAHOOCHEE TECHNICAL COLLEGE (US 4345141), Santa Fe University of Art and Design Logo (US 4550466), University of Houston Eagle design (US 4542443), and LOYOLA MARYMOUNT UNIVERSITY (US 4517837).

These marks are akin to “house” marks, and are of little value in showing that the services at issue are related. Specific educational services within extensive descriptions in the third-party

registrations should not be viewed in isolation.³ See, e.g., *In re Gebhard*, Serial No. 78950320, p. 6 (TTAB 2009) (non-precedential) (“We have given no weight to those third-party registrations for marks which are in the nature of house marks, designer marks and merchandising marks, as it is well-recognized that such marks may be used for a wide variety of items, and therefore they are of little value in showing that the goods for which they are registered are all related.”); *In re The Orris Co., Inc.*, Serial No. 78276739, p. 11 (TTAB 2007) (non-precedential) (“we find that the vast majority of [the examining attorney’s third party] registrations are analogous to house marks because the identifications of goods encompass a broad range of clothing, accessory and sporting goods products. Therefore, the inclusion of fishing vests, swimwear and/or leotards in the identifications of goods is not particularly significant.”) (emphasis added).

Furthermore, these and numerous others of the cited third-party registrations in evidence fail to recite all of Applicant’s and Registrant’s goods, respectively. Instead, a majority of the third party registrations recite services consistent with what more traditional four year universities offer, namely, a broad range of liberal arts and science classes combined with an athletic program. Neither Applicant nor Registrant fit this mold, the former being a two year technical school, the latter being a specialized entertainment and media school.

For example, the UNIVERSITY OF MOUNT UNION registration recites a broad range of liberal arts and scientific courses, but fails to recite instruction services for audio, film, video, television and digital media (Registrant’s services), as well as conducting distance learning instruction, on-line classes, and classes in the field of personal development (Applicant’s services).

³ For example, the Q logo registration (related to Queens College) recites a vast laundry list of educational services.

The same is true for the registrations for FLORIDA SOUTHERN COLLEGE, The University of Houston Eagle design, and the LOYOLA MARYMOUNT UNIVERSITY registration⁴.

This distinction as to types of schools is also shown among certain other of the third party registrations cited. While the MCAD and Santa Fe University of Arts and Design logo registrations recite services more in line with Registrant, these are both owned by design and arts focused entities. Moreover, these registrations do not recite all of Applicant's services. Rather, Applicant's recited services are more consistent with those recited in the registration for CHATTAHOOCHEE TECHNICAL COLLEGE, a technical and vocational centered entity like Applicant.

As to the two remaining third-party registrations cited, KNOWLEDGE BRANCH (US Registration 4446532) and PYRAMID (US 4465908), these also fail to show relatedness of Applicant's and Registrant's services. The KNOWLEDGE BRANCH registration recites services that are ancillary to those at issue, namely, education testing and survey services. Further, the PYRAMID registration is associated with an individual instructor offering tutoring and/or classes, but not an advanced, accredited degree.

Because the internet webpages are merely screenshots taken from the respective websites of a few of the third-party registrants, this evidence is redundant and does not provide any additional probative value. However, it is worth noting that these screenshots confirm Applicant's position that the third party registrations are for primary university marks, rather than secondary slogans.

Accordingly, without more, the third-party registrations and website materials cited by Examining Attorney are insufficient to prove Applicant and Registrant's goods are related.

⁴ Specifically, the LOYOLA MARYMOUNT UNIVERSITY registration does not recite instruction services for music, audio, video and digital media (Applicant's services), as well as conducting distance learning instruction, on-line classes, and classes in the field of personal development (Applicant's services).

ii) Reconsideration Letter Evidence

In the Reconsideration Letter, the Examining Attorney introduced numerous website excerpts alleged to show Applicant's and Registrant's services can emanate from the same source. *See* Reconsideration Letter (attachments 1-8). As before, these website excerpts standing alone are insufficient to show the services are related. Moreover, the content of the additional materials does nothing to enhance their probative value.

Specifically, Examining Attorney attached excerpts from the following websites: www.uncsa.edu, www.hunter.cuny.edu, and www.ccny.cuny.edu. Rather than bolster the alleged relatedness of the services at issue, these websites show that the services are provided in connection with university house marks. Primary university names and symbols are used so pervasively by their respective owners on a great variety of goods and services that the probative value of this type of evidence is diminished. *See In re Princeton Tectonics*, Serial No. 77436425 at p. 7 (The diversity of the goods listed in the registration "diminishes the probative value in establishing that any two items identified in the registration are related.").

After all, when similar marks are used in conjunction with house marks, the likelihood of confusion tends to be lessened rather than increased. *See, e.g., CareFirst of Maryland, Inc. v. First Care, P.C.*, 434 F.3d 263, 271, 77 U.S.P.Q.2d 1577, 1583 (4th Cir. 2006) (No confusion likely between senior CAREFIRST and junior FIRST CARE for physicians group medical office. The senior mark was often used with the prominent mark BLUE CROSS-BLUE SHIELD. "If one of two similar marks is commonly paired with other material, that pairing will serve to lessen any confusion that might otherwise be caused...."); *see also, Playtex Products, Inc. v. Georgia-Pacific Corp.*, 390 F.3d 158, 164, 73 U.S.P.Q.2d 1127, 1132 (2d Cir. 2004) ("We have repeatedly found that the presence of a distinct brand name may weigh against a finding of confusing similarity." Presence of house mark

NORTHERN prevents likely confusion), *superceded by statute based on other grounds as stated in Starbucks Corp. v. Wolfe's Borough Coffee, Inc.*, 588 F.3d 97, 92 U.S.P.Q.2d 1769 (2nd Cir. 2009).

The only other website cited, www.greatvaluecolleges.net, should be completely discounted, as it is merely a listing website for a number of colleges and does not show a single owner offers all the services of Applicant and Registrant. At most, this evidence shows that a variety of educational services from a number of sources can be found on the same website by a consumer. The Board has acknowledged that there is no *per se* rule that all goods or services sold under the same “roof” are related. *See, Nestle*, 4 U.S.P.Q.2d at 1090 (TTAB 1987) (precedential).⁵ The “roof” at issue here is the Internet. That the services of Applicant and Registrant are both found on the Internet proves little, if anything, about the likelihood that consumers will confuse similar marks used on such goods or services. *See Parfums de Coeur, Ltd. v. Lory Lazarus*, 83 U.S.P.Q.2d 1012, 1021 (TTAB 2007) (precedential) (“[T]he mere fact that goods and services may both be advertised and offered through the Internet is not a sufficient basis to find that they are sold through the same channels of trade. *The Internet is such a pervasive medium that virtually everything is advertised and sold through the Internet.* We therefore need something more....”) (emphasis added). This evidence falls short, therefore, of what is required to prove that purchasers would expect the allegedly related services to emanate from a single source.

⁵ *Accord The Irwin Auger Bit Co. v. Irwin Corp.*, 134 U.S.P.Q. 37, 39 (TTAB 1962) (precedential) (“It is common knowledge that there are sold in many hardware, grocery, variety and drug stores an almost unlimited variety of goods.... The public being well aware of the diversity of goods to be found in such stores is not going to believe that all of those goods could originate with a single source of origin.”); *accord Hi-Country Foods Corp. v. Hi Country Beef Jerky*, 4 U.S.P.Q.2d 1169, 1171-72 (TTAB 1987) (precedential) (all food products are not “related goods” merely because they are sold in the modern supermarket “with its enormous variety of food, cleaning, paper and other products”); *Zanella Ltd. v. Saroyan Lumber Co.*, Opposition No. 91153249, p. 22 (TTAB 2005) (non-precedential) (“In any event, in the case of department stores, the fact that a wide range of goods may be sold under the same roof does not automatically mean that the goods are related or that buyers are likely to ascribe a common source to the goods.”). *See also, In re Orvis Co., Inc.*, Serial No. 78276739 at p. 4-5 and 10-11 (“[W]e note that these retail sites offer these goods under a wide variety of brand names, none of which are the store name....” “In fact, the Internet evidence excerpted by the examining attorney indicates that these items are not marketed under the same marks or on the same Internet pages, even when offered by the same retailer.”).

b. Examining Attorney did not adequately consider the differences in the recitation of services.

Examining Attorney also failed to recognize the differences in the recitation of services. As Examining Attorney consistently asserted, the question of likelihood of confusion “must be determined based on an analysis of the goods or services recited in applicant’s application vis-à-vis the goods or services recited in the registration, rather than what the evidence shows the goods or services actually are.” *In re Orvis*, Serial No. 78276739 at p. 9, citing *Canadian Imperial Bank v. Wells Fargo Bank*, 811 F.2d 1490, 1 U.S.P.Q.2D 1813, 1815 (Fed. Cir. 1987). Applicant does not seek registration of “offering courses of instruction in art, music, audio, film, video, television and digital media.” Similarly, the Registered Mark does not include “providing courses of instruction at the college level and distribution of course material in connection therewith; Educational services, namely, providing on-line courses of instruction at the college level; Educational services, namely, conducting distance learning instruction at the college level; Educational services, namely, conducting classes in the field of career development and distribution of training material in connection therewith; Educational services, namely conducting classes in the field of personal development and distribution of course and educational materials in connection therewith.” Regardless of what might be assumed or discerned, the simple fact is that these are quite different descriptions when compared word for word.

c. Examining Attorney Gave Insufficient Weight to Nature of Services.

Examining Attorney also refused to factor in the nature of the services at issue in his determination. Notwithstanding any potential overlap of Applicant’s and Registrant’s services, the nature of the services strongly indicates that confusion is not likely. As Applicant asserted in its Request for Reconsideration: “The choice of post-secondary school is one of the most important decisions a person can make, one of the most expensive, and one having the most impact on an

individual.” While all the differences between programs offered by Applicant and Registrant may not be of record, the Examining Attorney failed to appreciate the consumer standpoint here and elsewhere. Applicant and Registrant are institutions of higher learning. Practically speaking, a consumer of this service will take great pains to understand the differences in the instruction offered.

Applicant is a vocational technical institute, and Registrant is a media and entertainment school. A consumer of Applicant’s type of education will be more inclined towards occupations in industry, whereas a consumer of Registrant’s type of education will prefer an occupation in entertainment or the arts. Stated differently, consumers of the respective services have decidedly different leanings regarding what type of education will be required to achieve their ultimate goals. Whatever slight, if any, overlap between Applicant’s and Registrant’s services exists, it is trumped by these manifest differences.

Viewed in its entirety, therefore, the evidence at most demonstrates that primary university brands are used in connection with a variety of educational services. However, the evidence also clearly shows the prominence of house marks. Furthermore, the evidence indicates that more specialized schools and programs, like those of Applicant and Registrant, do not provide this same variety or combination of educational services. Lastly, Applicant’s and Registrant’s recitation of services are patently distinct.

Based on the foregoing, Applicant respectfully asserts that Examining Attorney failed to present sufficient evidence to support a conclusion that Applicant’s and Registrant’s services are related such that consumers would expect them to emanate from a single source.

3. Similarity of Channels of Trade Is Unclear.

The third *Dupont* factor is as most neutral to the determination of likelihood of confusion. The record indicates that neither Applicant nor Examining Attorney focused on this factor. Other than blanket conclusions that the evidence showed the channels of trade are the same, Examining Attorney did not specify what the channels of trade are for either Applicant or Registrant. His assertions on this issue, therefore, merit no deference. See *In re St. Helena Hospital*, 774 F.3d 747, 753 (Fed. Cir. 2014) (citing *Nat'l Shooting Sports Found v. Jones*, 716 F.3d 200, 214 (D.C. Cir. 2013) (“We do not defer to an agency’s conclusory or unsupported suppositions.” (internal quotation omitted))).

Although Examining Attorney refers generally to his attached internet excerpts for the proposition that the services are sold through the same trade channels, the fact that the services are sold through the Internet should have no probative value. In the Twenty-First Century, the Internet has become the venue for the advertising and sale of all manner of goods and services. 4 McCarthy on Trademarks and Unfair Competition §24:53.50 (4th Ed. 2015). Thus, the reality of the marketplace for these services should not be ignored. *Guardian Prods. Co. v. Scott Paper Co.*, 200 U.S.P.Q. 738 (TTAB 1978) (precedential).

4. The Consumers are Careful and Sophisticated.

The fourth *Dupont* factor weighs decidedly against a finding of likelihood of confusion. More than simply failing to recognize this important factor, the Examining Attorney also erred in his findings.

a. Examining Attorney misinterpreted the Office’s precedent.

Before reaching the merits of Applicant’s position, Applicant notes that the Examining Attorney employed an incorrect, unsupported standard to consider the level of sophistication of the consumers. In particular, the Examining Attorney stated the following regarding this factor:

Applicant argues that the relevant consumers are sophisticated purchasers who would not be confused as to the source of the applicant's and registrant's services by the similar wording of applicant's and registrant's respective marks because education services are not impulse items. However, the fact that purchasers are sophisticated or knowledgeable in a particular field does not necessarily mean that ***they are sophisticated or knowledgeable in the field of trademarks*** or immune from source confusion.

See Final Office Action (citing TMEP §1207.01(d)(vii); *see, e.g., Stone Lion Capital Partners, LP v. Lion Capital LLP*, 746 F.3d. 1317, 1325, 110 USPQ2d 1157, 1163-64 (Fed. Cir. 2014); *Top Tobacco LP v. N. Atl. Operating Co.*, 101 USPQ2d 1163, 1170 (TTAB 2011). None of the authorities cited by the Examining Attorney supports his proposition that a consumer need be sophisticated or knowledgeable *in the field of trademarks* to make an impact on the likelihood of confusion. Commerce does not track trademark law; it is trademark law that tracks commerce. What this line of authority cited actually holds is that even sophisticated consumers are prone to confusion when the marks are very similar and/or the services are, as well. *Id.*

That the Examining Attorney relied on this incorrect standard is evident in the record. In at least the following statements, the Examining Attorney expressed a bias in favor of the Registrant over a relevant consumer:

- The overriding concern is not only to prevent buyer confusion as to the source of the services, but to protect the registrant from adverse commercial impact due to use of a similar mark by a new comer. *See* First Office Action and Final Office Action.
- Any doubt regarding a likelihood of confusion determination is resolved in favor of the registrant. *See* Final Office Action.
- [T]he Court of Appeals for the Federal Circuit and the Trademark Trial and Appeal Board have recognized that marks deemed “weak” or merely descriptive are still entitled to protection against the registration by a subsequent user of a similar mark for closely related goods and/or services. *See* Final Office Action.

While these statements might have legal support, the Examining Attorney appeared to only consider the Registrant's point of view. To seek to preserve the value of a trademark registration is

appropriate, but to completely disregard a consumer's mind set is not. The consumer's state of mind is the key to all trademark infringement law and determines most trademark disputes:

In the consideration of evidence relating to trademark infringement, therefore, a court must expand the more frequent, one-on-one, contest-between-two sides, approach. A third party, the consuming public, is present and its interests are paramount. ... A "trademark" is not that which is infringed. What is infringed is the right of the public to be free of confusion and the synonymous right of a trademark owner to control his product's reputation. ... Interested businessmen may sue for trademark infringement in the course of protecting their pocketbook. ... Thus the public need not rely wholly on government for protection against confusion, and need not pay the taxes such reliance would entail.

4 McCarthy on Trademarks and Unfair Competition §2:33 (4th ed. 2015), quoting *James Burrough Ltd. v. Sign of Beefeater, Inc.*, 540 F.2d 266, 274, 192 U.S.P.Q. 555 (7th Cir. 1976).

What also appears to be lacking from the examination of this and other factors are common sense and/or practical concerns. A ruling that is based merely on theoretical possibility is improper. See *In re Massey-Ferguson Inc.*, 222 USPQ 367, 368 (TTAB 1983) ("[w]e are not concerned with mere theoretical possibilities of confusion, deception or mistake or with de minimus situations but with the practicalities of the commercial world with which the trademark laws deal") (internal citation omitted).

Here, the Examining Attorney's concern for protecting the Registrant over the consumer was markedly imbalanced.

b. Examining Attorney presented no evidence disputing the consumers are sophisticated.

In addition to applying an incorrect standard, Examining Attorney presented no evidence to dispute Applicant's position that the consumers at issue are quite careful and sophisticated.

"[T]he burden is on the Trademark Examining Attorney to prove that there in fact is an overlap or similarity in purchasers and trade channels." *In re Band-it-IDEX, Inc.*, Serial No. 77363240, p. 15 (TTAB 2009) (non-precendential). The record confirms that the Examining

Attorney neither gave weight to, nor submitted any evidence regarding the degree of care by consumers for the respective services. *See, generally*, First Office Action, Final Office Action, and Reconsideration Letter. *See also, Dupont*, 476 F.2d 1357, 1361, 177 USPQ 563 (C.C.P.A. 1973) (whether buyers are likely to buy a product on “impulse” or after careful deliberation is an important factor in evaluating likelihood of confusion); *Information Clearing House, Inc. v. Find Magazine*, 492 F. Supp. 147, 162-63 (S.D.N.Y. 1980).

It is well established that when the relevant buyer class is composed of sophisticated parties, professionals or commercial buyers familiar with the field, this can reduce or prevent a likelihood of confusion. *See In re Bridger Management, LLC*, Serial No. 78516349, p. 10 (TTAB 2007) (customers are highly sophisticated and capable of distinguishing between the marks); *Hewlett Packard Co. v. Human Performance Measurement, Inc.*, 23 USPQ2d 1390 (TTAB 1991) (sophisticated buyers of medical instruments are not likely to be confused between “HP” and “HPM”); *Electronic Design & Sales Inc. v. Electronic Data Systems Corp.*, 21 USPQ2d 1388 (Fed. Cir. 1992) (sophistication is important and often dispositive because sophisticated consumers may be expected to exercise greater care); *Magnaflux Corp. v. Sonoflux Corp.*, 43 C.C.P.A. 868, 871, 231 F.2d 669 (1956) (confusion is less likely where the goods are expensive and are purchased after careful consideration than when they are inexpensive).

Without question, a consumer would not randomly or impulsively purchase a post-secondary education. Such a life altering decision would take much greater care than to simply join the cheapest or most convenient college available. Particularly in view of the current economic conditions, such a high-cost purchase would require even the least sophisticated within the buying class to make additional consideration prior to a purchase.

Significantly, the level of sophistication of consumers relevant here has been determined by at least one federal district court. In a trademark case involving similar circumstances between universities, the Florida district court held:

The Court finds that FIU has not established that Florida National University's mark creates a likelihood of confusion. Though "Florida National University" and "Florida International University" sound similar, there is little else about the two marks or the two schools that is likely to cause confusion in the marketplace. While there is some overlap in the degrees offered by FIU and FNU, most of FNU's students are pursuing degrees or courses that FIU doesn't offer, and the differences in academic standards for applicants suggest two vastly different pools of potential students, making the likelihood of confusion unlikely. Moreover, the Court finds that, *in light of the time and financial commitment college entails, a consumer in the market for a post-secondary degree should be considered a sophisticated or "well-informed" consumer less likely to be confused by a mark.*

See Florida Int'l University Board of Trustees v. Florida Nat'l University, Inc., 91 F. Supp. 2d 1265, 1284 (S.D. Fl.) (March 4, 2015) (internal citations omitted) (emphasis added). Accordingly, this district court has very recently confirmed Applicant's position that the consumers of higher education services are sophisticated and are less likely to be confused.

What is more, the relevant buying class is much smaller than anyone seeking an advanced degree. After all, admission is not available to the public at large. Only those individuals that are admitted by Applicant and Registrant are part of the buying class. That a student going through the rigorous admissions process would be confused as to which college was offering which classes based on the use of similar slogan is truly inconceivable.

Accordingly, the level of care exercised by this relatively small purchasing class is high and weighs against a finding of likelihood of confusion.

5. There Exist A Number of Similar Marks in Use With Similar Services.

The sixth *Dupont* factor also weighs against a finding of likelihood of confusion.

a. Third party registrations evidence portions of the marks are weak.

Although Applicant does not assert that the mark YOU CAN GET ANYWHERE FROM HERE as a whole is weak, certain portions of the mark are registered for similar services by third parties. “Third party registrations are relevant to prove that some segment of the composite marks which both contesting parties use has a normally understood and well-recognized descriptive or suggestive meaning, leading to the conclusion that that segment is relatively weak.” *Juice Generation*, 794 F.3d at 1339 (quoting 2 McCarthy on Trademarks and Unfair Competition § 11:90 (4th ed. 2015)). In its Response to the First Office Action, Applicant presented evidence of numerous third party registrations for similar marks in connection with similar services. The most relevant of these included:

- START HERE. GET THERE. (US Registration No. 4202110) for “Educating at university or colleges; Education services in the nature of courses at the university level; Education services, namely, providing on-line classes and online sessions in the field of career and technical training, professional continuing education units, adult education, English as a Second Language, and the following core curriculum fields designed to be transferred to another college or university: Anthropology, Archeology, Art, Biology, Business Administration, Chemistry, Computer Science, Creative Writing, Dance, Drama, Economics, Education, Engineering, English, Environmental Science and Technology, Foreign Language, General Studies, Geography, Geology, Government, Health and Kinesiology, History, Journalism, Mathematics, Music, Philosophy, Physics/Astronomy, Pre-Dental/Pre-Medical/Pre-Pharmacy/Pre-Veterinary, Psychology, Radio-Television-Film, Social Work, Sociology, Speech and the following career and technical fields: Accounting, American Sign Language and Interpreter Training, Architectural and Engineering Computer Aided Design, Auto Body Collision and Refinishing, Automotive Technology, Biotechnology, Building Construction Technology, Business and Technical Communications, Child Development, Commercial Music Management, Computer Information Technology, Criminal Justice, Culinary Arts, Dental Hygiene, Diagnostic Medical Imaging-Radiology, Electronics and Applied Technologies, Emergency Medical Services Professions, Environmental Technology, Financial Management, Fire Protection, Game Development, Heating, Air Conditioning, Refrigeration Technology, Hospitality Management, Human Services, International Business, Jewelry, Land Surveying Technology/Geomatics, Management, Marketing, Medical Coding, Medical Laboratory Technology, Meeting and Events Planning, Nursing-Professional, Nursing-Vocational, Occupational Therapy Assistant, Office Administration, Paralegal, Personal Fitness Trainer, Pharmacy Technician, Photographic Technology, Physical Therapist Assistant, Radio-Television-Film, Real

Estate Broker License, Sonography, Travel and Tourism, Visual Communication, Welding Technology, Development Education.”

- START HERE, GO EVERYWHERE (U.S. Registration No. 4521773) for “Educating at university or colleges; Education services in the nature of courses at the university level.”
- FROM HERE TO ANYWHERE (US Registration No. 4513928) for “Education services in the nature of courses at the university level; Providing courses of instruction at the undergraduate and graduate school level.”
- BE GREAT. STAY HERE. (US Registration No. 4001782) for “Educational services in a variety of fields, namely, providing classes and courses at the undergraduate, graduate, and doctoral levels.”
- LEARN HERE, LEAD ANYWHERE (US Registration No. 3003474) for “educational services, namely, undergraduate and graduate education in the field of business.”

See Response to First Office Action. Accordingly, Applicant identified no fewer than five similar marks owned by as many different third party registrants for marks and related services similar to those at issue here.

Similar to his disregard for consumer sophistication, the Examining Attorney gave no weight to Applicant’s compelling evidence as to the weakness of the marks’ shared terms. When presented with these third party registrations, the Examining Attorney provided merely a conclusory, unsupported response:

Applicant also points to a list of third-party marks to support the proposition that the registered mark is a weak mark. However, the majority of the cited marks are not federally registered marks, some having been abandoned, others cancelled, and others referred to as common law marks. *The cited registered third-party marks are either distinguishable from the registered mark as to the marks themselves or as to the goods and/or services with respect to which the marks are used.*

See Final Office Action (emphasis added). Contrary to Examining Attorney’s conclusion, the cited third party registrations contain many similar terms (e.g., HERE, ANYWHERE, THERE) and

further recited strikingly similar services (e.g., “courses at the college level”) to those of Applicant and Registrant.

By asserting that educational services listed together in the same third-party registration or on the same website are presumed to be related and/or traveling in the same trade channels, Applicant submits the Examining Attorney has defined the relevant market too broadly. Notwithstanding, these other third-party registrations are relevant based on the Examining Attorney’s position. *See Conde Nast Publications, Inc. v. American Greetings Corp.*, 329 F.2d 1012, 1014, 141 U.S.P.Q. 249, 251 (CCPA 1964) (It is well established that third-party registrations are competent, probative evidence to demonstrate that prior marks are commercially “weak,” thus narrowing the scope of rights accorded to prior users.). Collectively, no fewer than **five** registrations (owned by **five** separate third parties) for similar taglines with similar services exist on the Principal Register. Such widespread use demonstrates either that the cited marks are weak or that the relevant market has been defined too broadly.

Assuming that at least portions of the marks at issue are weak, the differences between the marks and recited services are significant. If the Registrant’s Mark is considered to be “weak,” “only slight differences in the marks ‘in the application and the registrations’ may be sufficient to distinguish one from the other.” *In re Melville Corp.*, 18 U.S.P.Q.2d 1386, 1388 (ITAB 1991) (precedential) (internal citations omitted). In a field where numerous entities use similar marks on allegedly similar services, each entity is relatively weak in its ability to prevent use by others of similar marks. *General Mills, Inc. v. Kellogg Co.*, 824 F.2d 622, 626-27, 3 U.S.P.Q.2d 1442, 1445 (8th Cir. 1987). Similarly, marks that are descriptive or highly suggestive are entitled to a narrower scope of protection, i.e., are less likely to generate confusion over source identification, than their more

fanciful counterparts. *See, e.g., Nat'l Data Corp. v. Computer Sys. Eng'g, Inc.*, 940 F.2d 676, 1991 WL 124920 at *2 (Fed. Cir. 1991).

b. The marks are slogans.

Another important factor, which Examining Attorney failed to recognize, is that Applicant's Mark and the Registered Mark are slogans, not primary university marks. It is generally held that commonly used phrases and slogans rarely achieve strong trademark significance. Even when federally registered, some slogans may merely be popular slang phrases with little distinctiveness. Such slogans are properly given a narrow scope of protection. For example, summary judgment for defendant was affirmed where plaintiff alleged that its registered mark COME ON STRONG for clothing was infringed by defendant's use of COME ON STRONG in its advertising of men's clothing. *B & L Sales Associates v. H. Daroff & Sons, Inc.*, 421 F.2d 352, 165 U.S.P.Q. 353 (2d Cir. 1970), *cert. denied*, 398 U.S. 952, 26 L. Ed. 2d 292, 90 S. Ct. 1873, 165 U.S.P.Q. 747 (1970). In another example, an opposition by the owner of the slogan "Always Makes a Good Impression" against applicant for "For a Lasting Impression" was dismissed on the ground that "highly laudatory" or "puffing" slogans are entitled to only very narrow protection. *Heyer, Inc. v. Popper & Sons, Inc.*, 152 U.S.P.Q. 196 (T.T.A.B. 1966).

As repeatedly asserted herein, the consumers at issue are highly sophisticated and discerning in view of the services being purchased. Certainly, such careful buyers will not be overcome and confused as to which college is offering which classes when faced with Applicant's and Registrants somewhat laudatory taglines, both of which would be combined with and dominated by, practically speaking, the primary school marks.

In view of the foregoing, the strength of the marks also weighs against a finding of likelihood of confusion.

VII. CONCLUSION

Applicant respectfully asserts that the Examining Attorney has not met the burden of proving a likelihood of confusion between Applicant's mark and the Registered Mark.

Applicant respectfully requests that the Board reverse the rejection and approve Applicant's Mark for publication.

Respectfully submitted,



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December 13, 2015

EXHIBIT – Unreported References

§ 2:33. Trademarks and consumer protection—Trademark protection is consumer protection

McCarthy on Trademarks and Unfair Competition, Fourth Edition | Fundamental Principles of Trademark Protection (Approx. 5 pages)

1 McCarthy on Trademarks and Unfair Competition § 2:33 (4th ed.)

McCarthy on Trademarks and Unfair Competition, Fourth Edition

Database updated December 2015

J. Thomas McCarthy

Chapter 2. Fundamental Principles of Trademark Protection

III. CONSUMER PROTECTION**References****§ 2:33. Trademarks and consumer protection—Trademark protection is consumer protection****West's Key Number Digest****West's Key Number Digest, Consumer Protection** 🔑6**West's Key Number Digest, Consumer Protection** 🔑7**West's Key Number Digest, Trademarks** 🔑1001**West's Key Number Digest, Trademarks** 🔑1421**West's Key Number Digest, Trademarks** 🔑1622

Plaintiff Acts as a Consumer Advocate. When a business sues for trademark infringement “the plaintiff is acting, not only in its own interest, but in the public interest.”¹ While the consumer is not a directly participating litigant, the consumer's state of mind is paramount. In this sense, protection of trademarks is merely a facet of consumer protection. The plaintiff in trademark litigation could be characterized as a “vicarious avenger” of consumer interests.

The consumer's² state of mind is key to all trademark disputes. There is no traditional trademark infringement unless there is a likelihood of consumer confusion or deception.³ It is the consumer's state of mind that largely controls the result:

In the consideration of evidence relating to trademark infringement, therefore, a court must expand the more frequent, one-on-one, contest-between-two sides, approach. A third party, the consuming public, is present and its interests are paramount. ... A “trademark” is not that which is infringed. What is infringed is the right of the public to be free of confusion and the synonymous right of a trademark owner to control his product's reputation. ... Interested businessmen may sue for trademark infringement in the course of protecting their pocketbook. ... Thus the public need not rely wholly on government for protection against confusion, and need not pay the taxes such reliance would entail.⁴

Trademark Infringement is a Form of Consumer Deception. As Justice O'Connor stated, trademark infringement not only “inhibits competition,” but also “deprives consumers of their ability to distinguish among the goods of competing manufacturers.”⁵ Trademark law insures that the brand information received by consumers is accurate: “By insuring correct information in the marketplace, the [trademark] laws reduce losses caused by misunderstanding and deceit and thus permit consumers and merchants to maximize their own welfare confident that the information presented is truthful.”⁶

Numerous decisions have stated that the law of trademarks and unfair competition rests not alone on a property right in the plaintiff, but in the right of the consuming public to be told the truth.⁷

The Dual Goals of Trademark Law. From its earliest beginnings in legal history, trademark law has had the dual goals of protecting property in a trademark and protecting consumers from confusion and deception.⁸ Both Congress and the Supreme Court have stressed that trademark law has these two goals.⁹ For example,

SELECTED TOPICS[Senior User of Mark Alleged Trademark Infringement](#)**Secondary Sources**[Actual competition as necessary element of trademark infringement or unfair competition](#)

148 A.L.R. 12 (Originally published in 1944)
...Unfair competition ordinarily consists in the simulation by one person of the name, symbols, or devices employed by a business rival, or the substitution of the goods or wares or services of one person...

[Liability for innocent infringement of trademark or tradename](#)

96 A.L.R. 651 (Originally published in 1935)
...As appears in 26 R. C. L. 874, 875, and 885, that the right to an injunction against the infringement of a trademark or a tradename is not affected by the fact that the infringer is acting innocently. ...

[Laches as affecting claim for accounting and damages in federal action for infringement of trademark or tradename](#)

14 A.L.R. Fed. 342 (Originally published in 1973)
...The doctrine of laches may be defined generally as a rule of equity by which equitable relief is denied to one who has been guilty of unconscionable delay, as shown by surrounding facts and circumstances...

[See More Secondary Sources](#)**Briefs****Brief for Petitioner**

2014 WL 4404693
B&B Hardware, Inc. v. Hargis Industries, Inc.
Supreme Court of the United States.
September 04, 2014

...In addition to the parties named in the caption, “East Texas Fasteners” and John Does 1-10 were named as defendants in the district court and listed as appellees in the court of appeals. Only Hargis In...

Joint Appendix

2014 WL 4628558
B & B Hardware, Inc. v. Hargis Industries, Inc.
Supreme Court of the United States.
September 04, 2014

...Peter J. Bezek, State Bar No. 102310 Roger N. Behle, Jr., State Bar No. 174755 Marisa D. Poulos, State Bar No. 197904 FOLEY BEZEK BEHLE & CURTIS, LLP 575 Anton Boulevard, Suite 710 Costa Mesa, California...

Appellant's Opening Brief

2012 WL 3164251
STREET SURFING, LLC, a Nevada limited liability company, Appellant/Plaintiff, v. GREAT AMERICAN E&S INSURANCE COMPANY, a Delaware corporation, Respondent/Defendant.
United States Court of Appeals, Ninth Circuit.
July 30, 2012

...Pursuant to Rule 26.1(a) of the Federal Rules of Appellate Procedure, Appellant Street Surfing, LLC has no parent corporation, and no publicly held corporation owns 10% or more of its stock. An appeal ...

[See More Briefs](#)**Trial Court Documents**[In re US Fideis, Inc.](#)

in the Supreme Court's 1992 *Taco Cabana* decision, Justice Stevens, concurring, observed that, in a Report accompanying the Lanham Act in 1946, the Senate emphasized that the Act had two goals:

The purpose underlying any trade-mark statute is twofold. One is to protect the public so it may be confident that, in purchasing a product bearing a particular trade-mark which it favorably knows, it will get the product which it asks for and wants to get. Secondly, where the owner of a trade-mark has spent energy, time, and money in presenting to the public the product, he is protected in his investment from its misappropriation by pirates and cheats. This is the well-established rule of law protecting both the public and the trade-mark owner.¹⁰

What Kind of Consumer Is Being Protected? The consumer who is to be protected is not necessarily the sophisticated buyer who makes careful distinctions, but a hypothetical "average consumer." "The law is not made for the protection of experts, but for the public—that vast multitude which includes the ignorant, the unthinking, and the credulous, who, in making purchases, do not stop to analyze, but are governed by appearances and general impressions."¹¹ Judge Learned Hand said he did not see why the ordinary "careless" buyer should be entitled to less protection from confusion over trademarks than "careful" buyers.¹²

Why Don't Consumers Sue for Themselves? Why do consumers need to rely on the trademark owner as their advocate or their vicarious avenger? The consumer who has mistakenly purchased a product branded JEM, mistakenly thinking he or she was buying the GEM brand is not going to file a suit for consumer fraud, even though such a person has a legal right to do so under state law.¹³ And, if the deception is truly effective, the consumer may not even be aware of it.

The amount of provable financial damage to one consumer, if any, is too small to justify expensive litigation. While consumers would have standing to sue under state law, the consumer's stake is small, making cost-efficient litigation a rarity. The consumer's interest would never be adequately protected by individual consumer lawsuits.

A consumer class action could meet formidable procedural difficulties.¹⁴ The courts will not allow consumers to sue in federal court under Lanham Act § 43(a).¹⁵ It is also unlikely, in most cases, that government consumer protection agencies will file suit.¹⁶

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Footnotes

- 1 [General Baking Co. v. Gorman](#), 3 F.2d 891, 893 (C.C.A. 1st Cir. 1925) ("In these cases, the infringer works a fraud upon dealer and customer alike; his palming off is piracy pure and simple."). For a contrary viewpoint see [Brown](#), *Advertising and the Public Interest: Legal Protection of Trade Symbols*, 57 Yale L.J. 1165 (1948).
- 2 Or "customer's," if the goods or services are sold to an intermediary such as a wholesaler or retailer.
- 3 See § 23:1.
- 4 [James Burrough Ltd. v. Sign of Beefeater, Inc.](#), 540 F.2d 266, 274, 192 U.S.P.Q. 555 (7th Cir. 1976) (Markey, C.J.).
- 5 [Inwood Laboratories, Inc. v. Ives Laboratories, Inc.](#), 456 U.S. 844, 854 n.14, 102 S. Ct. 2182, 72 L. Ed. 2d 606, 214 U.S.P.Q. 1, 34 Fed. R. Serv. 2d 1101 (1982).
- 6 [Falcon Rice Mill, Inc. v. Community Rice Mill, Inc.](#), 725 F.2d 336, 348, 222 U.S.P.Q. 197 (5th Cir. 1984). See discussion of the economic benefits of trademark protection at § 2:3.
- 7 See § 2:35; Posner, *Economic Analysis of Law* 81 (2d ed. 1977)

2011 WL 6012153
In re US Fidelis, Inc.
United States Bankruptcy Court, E.D.
Missouri,
July 25, 2011

...Chapter 11 On June 24, 2011, US Fidelis, Inc. (the "Debtor") and The New York State Catholic Health Plan, Inc., d/b/a Fidelis Care New York ("Fidelis Care") filed a Joint Motion for Order Approving Set...

In re Vcw Enterprises, Inc.

2013 WL 663148
In re Vcw Enterprises, Inc.
United States Bankruptcy Court, E.D.
Pennsylvania,
February 21, 2013

...Chapter 11 (Jointly Administered) Upon the motion, dated January 25, 2013 (the "Motion") of Vcw Enterprises, Inc. d/b/a M&W Precast, f/k/a Modern Precast Concrete, Inc. ("VCW"), West North, LLC ("West ...

In re Modern Precast Concrete, Inc.

2013 WL 663149
In re Modern Precast Concrete, Inc.
United States Bankruptcy Court, E.D.
Pennsylvania,
February 21, 2013

...Chapter 11 (Jointly Administered) Upon the motion (the "Motion"), dated December 6, 2012, of Modern Precast Concrete, Inc., West Family Associates, LLC, and West North, LLC, which commenced chapter 11 ...

[See More Trial Court Documents](#)

(Trademarks deter and prevent misrepresentation of source or sponsorship by creating private exclusive rights in trademark owners.).

8 See § 5:2.

9 See §§ 2:1 to 2:2.

10 S. Rep. No. 79-1333 (1946). Quoted in *Two Pesos, Inc. v. Taco Cabana, Inc.*, 505 U.S. 763, 782 n.15, 112 S. Ct. 2753, 120 L. Ed. 2d 615, 23 U.S.P.Q.2d 1081 (1992) (Stevens, concurring). See *Inwood Laboratories, Inc. v. Ives Laboratories, Inc.*, 456 U.S. 844, 854 n.14, 102 S. Ct. 2182, 72 L. Ed. 2d 606, 214 U.S.P.Q. 1, 34 Fed. R. Serv. 2d 1101 (1982) (Trademark infringement “inhibits competition” and “subverts both goals of the Lanham Act” by depriving the trademark owner of good will and by depriving consumers of the ability to distinguish among goods of competing manufacturers.).

11 *Florence Mfg. Co. v. J.C. Dowd & Co.*, 178 F. 73, 74 (C.C.A. 2d Cir. 1910), quoted in *Stork Restaurant v. Sahati*, 166 F.2d 348, 359, 76 U.S.P.Q. 374 (C.C.A. 9th Cir. 1948) (“The law, however, protects not only the intelligent, the experienced, and the astute. It safeguards from deception also the ignorant, the inexperienced, and the gullible.”). See discussion of the characteristics of the reasonably prudent consumer at §§ 23:91 to 23:103.

12 *American Chicle Co. v. Topps Chewing Gum*, 208 F.2d 560, 563, 99 U.S.P.Q. 362 (2d Cir. 1953) (“Why they should be deemed more legitimate game for a poacher than his careful buyers, it is hard to see, unless it be on the ground that he should have made his mark so conspicuous that it would serve to hold even the most heedless. Surely that is an inadequate defense.”).

13 The laws of most states would allow a legal claim. See, e.g., California Consumer Legal Remedies Act, *Cal. Civil Code § 1770*; see §§ 27:113 to 27:116.

14 See, e.g., *Hall v. Coburn Corp. of America*, 26 N.Y.2d 396, 311 N.Y.S.2d 281, 259 N.E.2d 720 (1970) (Not permitting consumer class action.); *In re Vioxx Class Cases*, 180 Cal. App. 4th 116, 103 Cal. Rptr. 3d 83 (2d Dist. 2009), review denied, (Mar. 30, 2010) (Rejecting consumer class action: individual issues predominated over common issues as to whether manufacturer's misrepresentations were material.). See *Dole, Deceptive Advertising as a Group Tort*, 62 Nw. U. L. Rev. 661 (1967).

15 See § 27:39.

16 For example, on the ground that the matter is “too trivial.” See: *Exposition Press, Inc. v. F. T. C.*, 295 F.2d 869, 873 (2d Cir. 1961) (“Judge Friendly argues with great force that this violation was trivial and that it is not in the public interest to kill this gnat with Commission dynamite. But it seems to us that once we say that the courts should exercise their judgment as to whether an alleged deception is of sufficient importance to warrant Commission action, we get into matters which are not entrusted to us ...”).

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§ 11:90. Third party registrations—Evidence of meaning of terms

McCarthy on Trademarks and Unfair Competition, Fourth Edition | The Spectrum of Distinctiveness of Marks (Approx. 3 pages)

2 McCarthy on Trademarks and Unfair Competition § 11:90 (4th ed.)

McCarthy on Trademarks and Unfair Competition, Fourth Edition

Database updated December 2015

J. Thomas McCarthy

Chapter 11. The Spectrum of Distinctiveness of Marks

VI. STRENGTH OF MARKS

D. THIRD PARTY USES AND REGISTRATIONS

References

§ 11:90. Third party registrations—Evidence of meaning of terms**West's Key Number Digest****West's Key Number Digest, Trademarks ☞ 1310**

A real evidentiary value of third party registrations per se is to show the sense in which a term, word, prefix or suffix of a mark is used in ordinary parlance. That is, third party registrations are similar to dictionaries showing how language is generally employed.¹ For example, introduction of many third party registrations for electronic products of marks with a -TRONICS or -TRONIX suffix could be evidence that those third parties and the public consider such a suffix descriptive and weak, such that there would be no likely confusion between DAKTRONICS and TEKTRONIX.²

Third party registrations are also probative to determine a common, weak significance of a part of a composite mark. Third party registrations are relevant to prove that some segment of the composite marks which both contesting parties use has a normally understood and well-recognized descriptive or suggestive meaning, leading to the conclusion that that segment is relatively weak. Such registrations could also show that the PTO, by registering several marks with such a common segment, recognizes that portions of such composite marks other than the common segment are sufficient to distinguish the marks as a whole and to make confusion unlikely. That is, the presence of such a descriptive or suggestive weak segment in conflicting composite marks is not per se sufficient to make confusion likely.³ For example, in one case, third party registrations showed that a five-sided box-with-a-roof design used in the real estate field is commonly perceived as a stylized representation of a house, as such is suggestive of housing and real estate, is a relatively weak segment, and therefore is not sufficient to make applicant's five-sided design confusingly similar to opposer's five-sided design.⁴

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Footnotes

- 1 Sams, Third Party Registrations in T.T.A.B. Proceedings, 72 Trademark Rep. 297 (1982).
- 2 Tektronix, Inc. v. Daktronics, Inc., 534 F.2d 915, 189 U.S.P.Q. 693 (C.C.P.A. 1976). *Accord*: Interstate Brands Corp. v. Celestial Seasonings, Inc., 576 F.2d 926, 928, 198 U.S.P.Q. 151 (C.C.P.A. 1978) (There was no error in the Trademark Board's use of nine third-party registrations to show the meaning of "zing" in the same way that dictionaries are used.).
- 3 See, e.g., Spraying Systems Co. v. Delavan, Inc., 762 F. Supp. 772, 19 U.S.P.Q.2d 1121, 1125 (N.D. Ill. 1991), *aff'd*, 975 F.2d 387, 24 U.S.P.Q.2d 1181 (7th Cir. 1992) (Third party registration of composites containing the "—JET" suffix were probative to show that it was descriptive for spray nozzles. "When the sole aim is to determine whether or not '—JET' is a

SELECTED TOPICS

Hallmark of Any Trademark Infringement Claim

[Lanham Trademark Act](#)**Secondary Sources****[Comment Note.—Doctrine of secondary meaning in the law of trademarks and of unfair competition](#)**

150 A.L.R. 1067 (Originally published in 1944)

...The present comment note attempts to consider all important phases and aspects of the doctrine of secondary meaning, that is, of the rules which in the law of trademarks and unfair competition pertain ...

[Application of secondary meaning test in action for trademark or tradename infringement under § 43\(a\) of the Lanham Act \(15 U.S.C.A. § 1125\(a\)\)](#)

86 A.L.R. Fed. 489 (Originally published in 1988)

...This annotation collects and analyzes the federal cases in which the courts have expressly applied the doctrine of secondary meaning in actions for trademark infringement under § 43(a) of the Lanham Act...

[Litigating Infringement of Trade Dress](#)

125 Am. Jur. Trials 117 (Originally published in 2012)

...This article discusses a cause of action for either likelihood of confusion or likelihood of dilution of a trade dress. "Trade dress" is a type of mark format. "Trade dress" is used to refer to a mark ...

[See More Secondary Sources](#)**Briefs****BRIEF FOR RESPONDENT**

1992 WL 672975

Two Pesos, Inc. v. Taco Cabana Intern., Inc. United States Supreme Court Respondent's Brief. April 10, 1992

...Respondent Taco Cabana operates a chain of upscale fast-food Mexican restaurants in Texas. Petitioner, in subsequently starting a competing restaurant chain (Two Pesos), deliberately copied the carefu...

BRIEF FOR RESPONDENT

1999 WL 1249422

Wal-Mart Stores, Inc. v. Samara Bros., Inc. United States Supreme Court Respondent's Brief. December 20, 1999

...All parties to the proceedings in the United States Court of Appeals for the Second Circuit are named in the caption. Respondent Samara Brothers, Inc. ("Samara") is a wholly-owned subsidiary of Samara ...

[Appeal Brief of Pebble Beach Company, Resorts of Pinehurst, Inc. and Sea Pines Company, Inc.](#)

1997 WL 33493375

PEBBLE BEACH COMPANY; Sea Pines Company Incorporated, Plaintiffs -- Appellees -- Cross Appellants, v. TOUR 18 LIMITED, Defendant -- Appellant -- Cross Appellee. RESORTS OF PINEHURST INCORPORATED, Plaintiff -- Appellee -- Cross Appellant, v. GOLF FORMS INCORPORATED; et al, Defendants, TOUR 18 LIMITED, Defendant -- Appellant -- Cross Appellee. United States Court of Appeals, Fifth Circuit. May 19, 1997

...This is an appeal of a final decision of the United States District Court for the Southern

descriptive term, it is unimportant that [the trademark proponent] was able to show that many of the registered trademarks were not in current use."); [Knight Textile Corp. v. Jones Investment Co.](#), 75 U.S.P.Q.2d 1313, 2005 WL 1691588 (T.T.A.B. 2005) (No confusion was likely between senior ESSENTIALS and junior NORTON MCNAUGHTON ESSENTIALS (both for women's apparel) because the basic word "essentials" was "highly suggestive" of clothing that is "essential" to a person's wardrobe. Twenty three third-party registrations of the term "essentials" helped to prove that both others in the field and the PTO have considered the word ESSENTIALS to have suggestive significance as applied to clothing.); [Truescents LLC v. Ride Skin Care, L.L.C.](#), 81 U.S.P.Q.2d 1334, 2006 WL 3326525 (T.T.A.B. 2006) (No confusion was likely between senior GENUINE SKIN and junior GENUINE RIDE SKIN CARE and design (both for skin care products) because the basic word "genuine" was a weak, laudatory term. Forty-six third-party registrations in which the term "genuine" appeared and was disclaimed helped to prove that "genuine" has a laudatory and descriptive meaning indicating the product is real and authentic.); [Rocket Trademarks Pty Ltd. v. Phard S.p.A.](#), 98 U.S.P.Q.2d 1066, 1075, 2011 WL 810221 (T.T.A.B. 2011) (No confusion was likely between senior ELEMENT and junior ZU ELEMENTS (both for apparel). Third party registrations evidenced that "element" was suggestive of clothing that is an "element" of a person's wardrobe.).

4

[Red Carpet Corp. v. Johnstown American Enterprises, Inc.](#), 7 U.S.P.Q.2d 1404 (T.T.A.B. 1988). *Accord:* [Top Tobacco, L.P. v. North Atlantic Operating Co., Inc.](#), 101 U.S.P.Q.2d 1163, 1173, 2011 WL 6099691 (T.T.A.B. 2011) (That the USPTO has allowed a number of tobacco-related mark registrations including the word CLASSIC to co-exist is evidence that CLASSIC has a recognized meaning such that the inclusion of the word in a combination may be insufficient for confusion to be likely. But the Board still found CLASSIC AMERICAN BLEND to be confusingly similar to CLASSIC CANADIAN, both for smoking tobacco.).

District of Texas entered November 8, 1996, in a case brought in part under the Trademark Act, 15 U.S.C. § 105...

[See More Briefs](#)

Trial Court Documents

[In re Kabuto Arizona Properties, LLC](#)

2009 WL 8188865
In re Kabuto Arizona Properties, LLC
United States Bankruptcy Court, D. Arizona,
May 22, 2009

...Dated: December 09, 2009 Chapter 11
Upon consideration of the Debtor's Motion For
Authority to Sell Substantially All of the
Debtor's Assets and Certain Assets of the
Debtor's Affiliates as a Going Con...

[In re Hampton Capital Partners, LLC](#)

2013 WL 5576264
In re Hampton Capital Partners, LLC
United States Bankruptcy Court, M.D. North
Carolina,
August 08, 2013

...This matter came before the Court after due
notice and hearing on July 30, 2013 (the "Sale
Approval Hearing") in connection with the
Motion (1) To Approve Private Sale of Certain
Intellectual Property ...

[In re 1701 Commerce, LLC](#)

2013 WL 358621
In re 1701 Commerce, LLC
United States Bankruptcy Court, N.D. Texas,
January 25, 2013

...Chapter 11 On October 16, 2012 (the "Sale
Hearing") came on for consideration the
Debtor's Motion for an Order: (I) Approving
Asset Purchase Agreement; (II) Authorizing
the Sale of its Assets Free and ...

[See More Trial Court Documents](#)

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§ 24:53.50. Use of the Internet for selling or advertising

McCarthy on Trademarks and Unfair Competition, Fourth Edition | Infringement by Use of Mark on Noncompetitive Goods or Services (Approx. 5 pages) **SELECTED TOPICS**

4 McCarthy on Trademarks and Unfair Competition § 24:53.50 (4th ed.)

McCarthy on Trademarks and Unfair Competition, Fourth Edition

Database updated December 2015

J. Thomas McCarthy

Chapter 24. Infringement by Use of Mark on Noncompetitive Goods or Services

I. RELATED GOODS OR SERVICES

H. PRODUCTS SOLD THROUGH SAME CHANNELS OF TRADE

References

§ 24:53.50. Use of the Internet for selling or advertising

West's Key Number Digest

West's Key Number Digest, Trademarks 🔑1116

West's Key Number Digest, Trademarks 🔑1435

Scope Note. The subject of an infringement occurring in cyberspace, usually by way of an infringing domain name, is discussed elsewhere in this treatise.¹ The issue discussed here is the extent to which, if any, that use of the Internet as a selling or advertising tool by both parties to a trademark infringement case increases the likelihood of confusion.

The Changing View of the Ninth Circuit. The Ninth Circuit has moved quite a distance away from its initial position that if the owners of both marks utilize the Internet as a marketing and advertising tool, this heightens the likelihood of confusion. By about a decade later, the same court was at the very different position that, because of the ubiquity of Internet use and the widespread Internet presence of all kinds of commercial companies, the fact that both parties appear on the Internet will shed little, if any, light on whether confusion is likely or not.

In the early days of the Internet, the Ninth Circuit said the use of similar marks on different Web sites might well create a likelihood of confusion:

[F]or now, we can safely conclude that the use of remarkably similar trademarks on different web sites creates a likelihood of confusion amongst Web users. ... We now reiterate that the Web, as a marketing channel, is particularly susceptible to a likelihood of confusion since, as it did in this case, it allows for competing marks to be encountering at the same time, on the same screen.²

But soon, the court moderated its view when, in the 2002 *Entrepreneur* decision, it stated that: "Some use of the Internet for marketing, however, does not alone and as a matter of law constitute overlapping marketing channels."³ The Sixth Circuit agreed, remarking that: "[A] non-specific reference to Internet use is no more proof of a company's marketing channels than the fact that it is listed in the Yellow Pages of the telephone directory."⁴

By 2011, the court had reached the position that the fact that both parties utilized the Internet was of very little weight in a likelihood of confusion balancing test: "Today, it would be the rare commercial retailer that did not advertise online, and the shared use of a ubiquitous marketing channel does not shed much light on the likelihood of consumer confusion."⁵ Judge Kozinski's view was that in a domain name dispute, "[t]he relevant marketplace is the online marketplace, and the relevant consumer is a reasonably prudent consumer accustomed to shopping online."⁶

Use of Internet Sales or Auction Site. Similarly, the fact that the goods of both parties are sold on the Internet at the eBay auction site is not proof that the goods move in the same channels of trade or that if bearing the same mark, they would be seen by consumers as coming from the same or an affiliated source.⁷

Similarity Between Trademarks

Likelihood of Confusion

Claims of Federal Trademark
Infringement Under Lanham Trademark
Act

Secondary Sources

Liability for innocent infringement of trademark or tradename

96 A.L.R. 651 (Originally published in 1935)
...As appears in 26 R. C. L. 874, 875, and 885, that the right to an injunction against the infringement of a trademark or a tradename is not affected by the fact that the infringer is acting innocently. ...

"Post-sale confusion" in Trademark or Trade Dress Infringement Actions under § 43 of Lanham Trade-Mark Act (15 U.S.C.A. § 1125)

145 A.L.R. Fed. 407 (Originally published in 1998)
...This annotation collects and analyzes those federal cases in which the courts have discussed "post-sale confusion" in trademark or trade dress infringement actions under 43(a) of the Lanham Trade-Mark ...

Reverse Confusion Doctrine Under Lanham Trademark Act

187 A.L.R. Fed. 271 (Originally published in 2003)
...This annotation collects and discusses all of the federal cases concerning "reverse confusion" in trademark infringement actions brought under the Lanham Trademark Act. Related Annotations are located ...

See More Secondary Sources

Briefs

Petition for a Writ of Certiorari

2004 WL 2569705
Dippin' Dots, Inc. v. Frosty Bites Distribution, LLC
Supreme Court of the United States.
November 10, 2004
...Petitioner Dippin' Dots, Inc. has no parent corporations, and there are no publicly held companies that hold 10% or more of petitioner's stock. The opinion of the Eleventh Circuit is reported at 369 F....

Petition for a Writ of Certiorari

2005 WL 2395958
1-800 Contacts, Inc. v. WhenU.Com, Inc.
Supreme Court of the United States.
September 21, 2005
...FN* Counsel of Record Pursuant to Rule 14.1(b), the following list identifies all the parties appearing here and before the United States Court of Appeals for the Second Circuit: The Petitioner here an...

Petition for a Writ of Certiorari

2004 WL 3206724
DIPPIN' DOTS, INC., Petitioner, v. FROSTY BITES DISTRIBUTION, LLC, Respondent.
United States Supreme Court.
November 10, 2004
...Petitioner Dippin' Dots, Inc. has no parent corporations, and there are no publicly held companies that hold 10% or more of petitioner's stock. The opinion of the Eleventh Circuit is reported at 369 F....

See More Briefs

Trial Court Documents

Case Sensitive Issues. Internet search engines are not case sensitive. Thus, when the Internet is a significant factor in the marketing efforts of the parties, a court will not draw a line between a trademark in a term in capitalized words and a version of that term in uncapitalized words. This led a court to modify an injunction to not only bar defendant from using plaintiff's mark "Independent Living Aids," but also the uncapitalized version "independent living aids."⁸

Author's Comment: The argument that the goods are "related" in a trademark infringement sense because they are both marketed over the Internet (or if both types of goods are found on the eBay Web site) suffers from the same fallacy as the old "under the same roof" argument.⁹ In the modern marketing environment of mega-sized stores selling all manner of goods, "under the same roof" is not probative of a likelihood of confusion. Similarly, in the Twenty-First Century, the Internet has become the venue for the advertising and sale of all manner of goods and services. That the goods or services of the parties are both found on the Internet proves little, if anything, about the likelihood that consumers will confuse similar marks used on such goods or services.¹⁰

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Footnotes

- 1 See §§ 25:68 to 25:77.
- 2 [GoTo.com, Inc. v. Walt Disney Co.](#), 202 F.3d 1199, 1207, 53 U.S.P.Q.2d 1652 (9th Cir. 2000) ("Navigating amongst web sites involves practically no effort whatsoever, and arguments that Web users exercise a great deal of care before clicking on hyperlinks are unconvincing."). Following [Brookfield Communications, Inc. v. West Coast Entertainment Corp.](#), 174 F.3d 1036, 1057, 50 U.S.P.Q.2d 1545, 1559 (9th Cir. 1999) ("[B]oth utilize the Web as a marketing and advertising facility, a factor that courts have consistently recognized as exacerbating the likelihood of confusion." Court found infringement.). But dissenting voices were heard: [Bally Total Fitness Holding Corp. v. Faber](#), 29 F. Supp. 2d 1161, 50 U.S.P.Q.2d 1840 (C.D. Cal. 1998) (Fitness studios and Web site design services are not related even though both have a presence on the Internet.).
- 3 [Entrepreneur Media, Inc. v. Smith](#), 279 F.3d 1135, 1151, 61 U.S.P.Q.2d 1705 (9th Cir. 2002) ("On the current record, it does not appear that either parties' use of the Web is significant enough to be pertinent." The court said it is only if both parties make use of the Internet as a "substantial" marketing tool that this factor becomes significant.).
- 4 [Therma-Scan, Inc. v. Thermoscan, Inc.](#), 295 F.3d 623, 637, 63 U.S.P.Q.2d 1659, 2002 FED App. 0227P (6th Cir. 2002). Compare [PACCAR Inc. v. TeleScan Technologies, L.L.C.](#), 319 F.3d 243, 65 U.S.P.Q.2d 1761, 2003 FED App. 0040P (6th Cir. 2003) (Use by both parties of the Internet increases the likelihood of confusion.).
- 5 [Network Automation, Inc. v. Advanced Systems Concepts, Inc.](#), 638 F.3d 1137, 1151–1152, 97 U.S.P.Q.2d 2036 (9th Cir. 2011) ("[T]he default degree of consumer care is becoming more heightened as the novelty of the Internet evaporates and online commerce becomes commonplace."). Accord: [Groupon, LLC v. Groupon, Inc.](#), 826 F. Supp. 2d 1156, 101 U.S.P.Q.2d 1341 (N.D. Cal. 2011) (Denying preliminary injunction: GROUPION web-based software for small and medium sized businesses versus GROUPON for "deal of the day" website. "[T]he shared use of the internet as a marketing channel is ubiquitous and thus does not shed much light on the likelihood of consumer confusion."). Later proceedings in [Groupon, LLC v. Groupon, Inc.](#), 859 F. Supp. 2d 1067, 1077, 103 U.S.P.Q.2d 1326 (N.D. Cal. 2012) (summary judgment of dismissal).
- 6 [Toyota Motor Sales, U.S.A., Inc. v. Tabari](#), 610 F.3d 1171, 1178, 95 U.S.P.Q.2d 1702 (9th Cir. 2010) (But concurring Judge Fernandez chided Judge Kozinski for inserting in the opinion his personal views about

In re Vcw Enterprises, Inc.

2013 WL 663148
In re Vcw Enterprises, Inc.
United States Bankruptcy Court, E.D.
Pennsylvania,
February 21, 2013

...Chapter 11 (Jointly Administered) Upon the motion, dated January 25, 2013 (the "Motion") of Vcw Enterprises, Inc. d/b/a M&W Precast, f/k/a Modern Precast Concrete, Inc. ("VCW"), West North, LLC ("West ...

In re Modern Precast Concrete, Inc.

2013 WL 663149
In re Modern Precast Concrete, Inc.
United States Bankruptcy Court, E.D.
Pennsylvania,
February 21, 2013

...Chapter 11 (Jointly Administered) Upon the motion (the "Motion"), dated December 6, 2012, of Modern Precast Concrete, Inc., West Family Associates, LLC, and West North, LLC, which commenced chapter 11 ...

In re Modern Precast Concrete, Inc.

2012 WL 6850436
In re Modern Precast Concrete, Inc.
United States Bankruptcy Court, E.D.
Pennsylvania,
June 12, 2012

...Chapter 11 Upon the motion (the "Motion"), dated December 6, 2012, of Modern Precast Concrete, Inc., West Family Associates, LLC, and West North, LLC, which commenced chapter 11 cases (each a "Case" an...

[See More Trial Court Documents](#)

hypothetical matters of consumer behavior not based on any factual evidence in the record.).

- 7 [Standard Knitting, Ltd. v. Toyota Jidosha Kabushiki Kaisha](#), 2006 WL 173463, 77 U.S.P.Q.2d 1917 (T.T.A.B. 2006), appeal dismissed, 2006 WL 1876836 (Fed. Cir. 2006) (the fact that clothing and vehicles can both be found on the eBay auction Web site does not prove that the goods are "related" in the sense that the use of the marks on such goods would be likely to cause confusion).
- 8 [Independent Living Aids, Inc. v. Maxi-Aids, Inc.](#), 303 F. Supp. 2d 327, 70 U.S.P.Q.2d 1238 (E.D. N.Y. 2004), *aff'd*, 127 Fed. Appx. 533 (2d Cir. 2005). See: [Brookfield Communications, Inc. v. West Coast Entertainment Corp.](#), 174 F.3d 1036, 1055, 50 U.S.P.Q.2d 1545 (9th Cir. 1999) ("In terms of appearance, there are differences in capitalization and the addition of ".com" in West Coast's complete domain name, but these differences are inconsequential in light of the fact that Web addresses are not caps-sensitive and that the ".com" top-level domain signifies the site's commercial nature.").
- 9 See § 24:45.
- 10 [Parfums de Coeur, Ltd. v. Lory Lazarus](#), 83 U.S.P.Q.2d 1012, 1021, 2007 WL 683784 (T.T.A.B. 2007) ("[T]he mere fact that goods and services may both be advertised and offered through the Internet is not a sufficient basis to find that they are sold through the same channels of trade. The Internet is such a pervasive medium that virtually everything is advertised and sold through the Internet. We therefore need something more"); [True Fit Corp. v. True & Co.](#), 106 U.S.P.Q.2d 1405, 1410, 2013 WL 789213 (D. Mass. 2013)(Quoting treatise. Both parties marketed on the internet: preliminary injunction denied.).

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